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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,955	02/05/2004	Christine A. Dimmig	Dimmig-1	3857

32132 7590 06/15/2005
LAMORTE & ASSOCIATES P.C.
P.O. BOX 434
YARDLEY, PA 19067

EXAMINER

PIERCE, WILLIAM M

ART UNIT PAPER NUMBER

3711.

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/771,955

Applicant(s)

DIMMIG, CHRISTINE A.

Examiner

William M. Pierce

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-16, 18 and 19 is/are rejected.
- 7) ☒ Claim(s) 12, 16 and 17 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

WILLIAM M. PIERCE
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 8, "said playing cards" lack a proper antecedent. Should delete "playing".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by LeCapelain 4,470,821.

As to claim 1, LeCapelain '821 shows a board 10, playing tiles 20 and question cards 30. As to claim 2, the limitation of "specialty spaces" contains limiting restrictions such that one can interpret the claim so broad as that the "middle" spaces are considered "specialty" spaces.¹ As to claim 3, fig. 1(c) is considered to show an arrangement of spaces in columns and rows. As to claim 8, all question are considered "variable" and depending "upon the person answering the question". As such '821 is considered to meet the limitations of this claim \

Claims 9-11 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated Smith 3,191,938.

As to claim 9, 11, 13 and 14, Smith shows providing words 14 with scoring values 30 to form sentences as shown in fig. 4.. As to claim 10 the words are considered to share a common theme as "places" such as "school and "where you live" as shown in fig. 4. As to claim 15, the middle spaces on the game board can be considered "specialty spaces". See footnote below.

Claims 18 and 19 rejected under 35 U.S.C. 102(b) as being anticipated Trager 3,482,333.

¹ Alternatively, specialty spaces are old in word games where their use invokes special rules. The game of Scrabble is the best known use of specialty spaces where there is a double or triple score recorded for the use of the space. While this rejection is not made under 103, applicant should take into account the structure known in the art to "specialty spaces" when considering amendments to the claims.

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Rager shows players attempting to form sentences and adding playing pieces when a player fails to form a sentence by "receiving three new cards" col. 3, ln. 47. As to claim 19 a player is enabled to alter the tense of a word by adding another card to the end or a root word.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeCapelain 4,470,821 as set forth above in view of Nason 3,618,231.

While '821 does not discuss an erasable marker, Nason teaches that it would have been obvious to have included such in a word forming game to allow players to write indicia on the playing pieces. As to claim 6, '821 is considered to show root words and "spaces" where there is no written indicia on the tiles. The functional limitations of adding a suffix using the erasable marker fails to distinguish over the art since what is being claimed is an apparatus. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

Claims 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeCapelain 4,470,821 as set forth above in view of Schroeder 6,422,561.

While '821 does not discuss the use of a point value on tiles, it is old and well known to include such on tile of word game in order to determine a score for a player as taught by '561.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Holland, Hunt, Williams and Barret show word game.

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Claims 12, 16 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Altering the words as called for in claim 12 and the combination of question cards with the recited steps as in claim 16 is not fairly taught by this art of record.

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (571) 272-4414.

For **official fax** communications to be officially entered in the application the fax number is (703) 872-9306.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.



WILLIAM M. PIERCE
PRIMARY EXAMINER